



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,178	01/14/2002	Seung Choul Yang	056090-5001	5055
9629	7590	11/19/2003		
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EXAMINER RAMANA, ANURADHA	
			ART UNIT 3732	PAPER NUMBER
			DATE MAILED: 11/19/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/043,178

Applicant(s)

YANG ET AL.

Examiner

Anu Ramana

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 32 and 33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Election/Restrictions***

Applicants' election without traverse of the invention of Group I in Paper No. 4 filed on September 29, 2003 is acknowledged. Accordingly, this office action addresses only claims 1-31 and 34. A complete reply to this Office Action must include cancellation of nonelected claims 32 and 33.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "through-hole" of claims 25 and 29 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference elements mentioned in the description: "50," "60," "70," "80," and "90."

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference elements not mentioned in the description: "21" and "23."

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The abstract of the disclosure is objected to because of the phrase, "The present invention". The abstract should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. See MPEP § 608.01(b).

The use of the trademark "Hassan" (Para [0039], line 7) has been noted in this application. The trademark should be capitalized wherever it appears and should be accompanied by the generic terminology.

Art Unit: 3732

Although the use of trademarks is permissible in patent applications, the proprietary nature of the trademarks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 3, 4, 7, 26-27 and 30-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 4 recite the limitation “the first tissue.” There is insufficient antecedent basis for this limitation in the claims.

Claim 7 recites the limitation, “the laparoscopic opening.” There is insufficient antecedent basis for this limitation in the claims.

Claims 26 and 27 recite the limitation “the first piercing retractor.” There is insufficient antecedent basis for this limitation in the claims.

In claims 26 and 30, it is unclear how the grip secures the first end portion of the retractor.

In claims 27 and 31, it is unclear how the retractor bar secures the first end portion of the retractor.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 9-11 and 24-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Reddy (US 5,352,219).

Art Unit: 3732

Reddy discloses a surgical tool or piercing retractor 10 for use in laparoscopic procedures with a first end portion 28 and a handle or grip 24 secured to the first end portion 28 via a shaft or "retractor bar" 12 wherein the first end portion 28 is used to puncture a wall of a body and a second end portion 14 of the retractor having a blade 46 to lift the wall (Figures 1-3, and 7, col. 1, lines 6-9, col. 2, lines 17-42, col. 3, lines 56-66, col. 4, lines 13-38 and lines 57-68 and col. 5, lines 7-9 and lines 18-21).

Regarding claims 25 and 29, Reddy further discloses that second end portion 14 has a through-hole 38 with a diameter greater than the first end portion 28 and smaller than the second end portion 46 (Figures 1 and 7).

The method steps of claims 1 and 9-11 are inherently performed during laparoscopic surgery utilizing the Reddy device.

Claims 1, 2 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Sava (US 5,931,777).

Sava discloses a surgical instrument 10 with a first arm or "piercing retractor" 12 having a piercing tip or "first end" 26 and a second end, a second arm or "piercing retractor" 14 having a piercing tip or "first end" 26 and a second end, wherein the blade 22 of the second piercing retractor is used to hold back tissue (Figures 1-4, col. 3, lines 45-67 and col. 4, lines 21-29).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reddy in view of Smith (US 5,176,129).

Reddy does not disclose the use of a surgical instrument or "forceps" or "needle driver" with a bent handle.

Art Unit: 3732

Smith teaches a retractor or surgical instrument or “forceps” or “needle driver” 72 during surgical procedures for continually holding open the skin at a wound or incision without requiring continuous application of manual or tactile force wherein instrument 72 has pad portions or a bent handle 76 to facilitate gripping by the thumb or forefinger of the health care professional (Figure 12, col. 1, lines 6-8, col. 2, lines 12-17, col. 5, lines 13-30, col. 6, lines 61-68 and col. 7, lines 1-2).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized the Smith forceps or needle driver during a laparoscopic procedure utilizing the Reddy device for the purpose of continually holding open the skin at an incision without requiring continuous application of manual or tactile force during the surgical procedure.

Claims 5-7 and 12-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reddy. See discussion for claim 1.

Reddy discloses surgical instrument or retractor 10 as having a grip 24 and a retractor bar 12 securing the first end portion of the retractor to grip 24. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the grip and the first end portion separable, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

The method steps of claims 5 and 6 are rendered obvious by the above discussion.

Regarding claim 7, Reddy discloses a laparoscopic opening having a length of about 2 to 5 mm for use with retractor 10. Applicants have failed to establish the criticality of a laparoscopic opening with a length of about 7 to 10 cm. It is the Examiner’s opinion that any suitable dimension could be used and thus the Reddy device would perform equally well in the claimed method.

Regarding claims 12-23, Reddy discloses that retractor 10 is used for surgical procedures. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the Reddy retractor during any type of surgical procedure for the purpose of lifting and pushing tissue.

Art Unit: 3732

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reddy in view of Piskun (US 6,454,783).

Reddy does not disclose a telescope inserted through a trocar. See discussion for claim 1.

Piskun teaches the use of a telescope inserted through a trocar during a laparoscopic procedure to visualize the operative field (col. 1, lines 23-31).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized a telescope inserted through a trocar, as taught by Piskun, during a laparoscopic procedure utilizing the Reddy retractor, for the purpose of visualizing the operative field.

The method steps of claim 34 are thus rendered obvious by the combination of Reddy and Piskun.

Conclusion

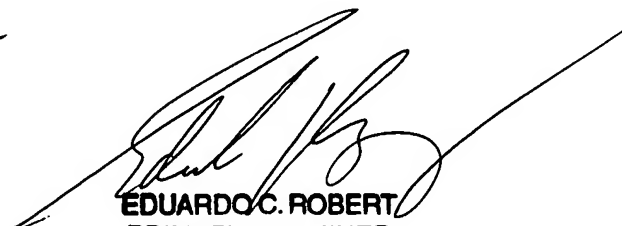
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (703) 306-4035. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

AR *Anuadha Ramana*
November 4, 2003


EDUARDO C. ROBERT
PRIMARY EXAMINER